

REMARKS

I. Introduction

In response to the Office Action dated April 24, 2008, Applicants have amended claims 1 and 12 to further clarify the present invention. Care has been taken to avoid the introduction of new matter.

An RCE is being filed concurrently with this amendment.

Applicants appreciate the granting of an interview with the Examiner on July 11, 2008, during which the rejections of claims 13-15 were discussed. During the interview, the Examiner stated that Germain does not disclose a connecting member connecting a power source terminal with a metal portion of an article joint or that the connecting portion has an insulating coating. As such, the Examiner suggested to incorporate this limitation into claim 1 to distinguish the claim over the prior art. Applicants have followed the Examiner's suggestion, and have added the limitation to claim 12 as well.

In response to the pending Office Action, Applicants respectfully submit that all pending claims are patentable over the cited prior art for the reasons set forth below.

II. The Rejection Of Claims 1, 3-13 And 15 Under 35 U.S.C. § 103

Claims 1 and 3-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Frager et al. (USP No. 2,480,845) in view of Eaton et al. (USP No. 2,416,294); and claims 13 and 15 were rejected as being unpatentable over Germain et al. (USP No. 3,575,829) in view of Frager. As the limitation of claim 13 deemed to be allowable over Germain and Frager has been incorporated into independent claims 1 and 12, Applicants will discuss this cited prior art in addressing claims 1, 12 and 13. Applicants respectfully traverse these rejections for at least the following reasons.

With regard to the present invention, amended claims 1 and 12 and claim 13 each recite, in-part, a method or apparatus for separating metal resin joint in which a part of a connecting member for electrically connecting one terminal of a power source with the metal portion of a joint of an article comprising the metal-resin joint and comprising a conductive material, is coated with an insulating oxide layer.

It is alleged that Germain teaches a connecting member 24 (a roll) having an insulating oxide layer. As is shown in Figs. 1 and 2 of Germain, the roll (alleged connecting member) 24 does not electrically connect a power source 36 with a metal portion of a joint. In fact, there is no metal-resin joint disclosed in Germain. As such, it is improper to consider the roll 24 a connecting member at all. Moreover, the leads 62 and 64 electrically connect the power source with the roll 24. However, leads 62 and 64 are not coated with an oxide layer. As such, Germain fails to disclose a connecting member coated with an insulating oxide layer, which is for electrically connecting one terminal of a power source with the metal portion of a metal-resin joint. Moreover, neither Frager nor Eaton is relied upon to remedy this deficiency.

As is well known, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974), and as Germain, Eaton and Frager fail to disclose a method or apparatus for separating a metal resin joint in which a part of a connecting member for electrically connecting one terminal of a power source with the metal portion of said joint of said article comprising the metal-resin joint and comprising a conductive material, is coated with an insulating oxide layer, it is submitted that Germain, Eaton and Frager, alone or in combination, do not render claims 1, 12, 13, or any pending claims dependent thereon, obvious.

**III. All Dependent Claims Are Allowable Because The
Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 12 and 13 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

Moreover, with regard to claim 6, it is alleged that Eaton teaches that agitation or vibration further raises the bath current density. However, Eaton does not discuss the use of ultrasound to assist in the separation of the plastic from metal. As such, the combination of Eaton and Frager also fail to render claim 6 obvious.

IV. Conclusion


Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

Application No.: 10/513,966

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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